

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte REGINALD P. WARKENTIN

Appeal No. 2003-2047
Application No. 09/938,479

ON BRIEF

Before KRATZ, MOORE, and POTEATE, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 8-17, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a chart recorder including a housing including a digitizer and multiple movable arms having digitizer detectable elements mounted in the housing. An understanding of the invention can be derived from a reading of exemplary claim 8, which is reproduced below.

8. A chart recorder, comprising:
a housing;
a backing plate installed in the housing;
multiple movable arms, each having an indicating tip, each movable arm, being mounted in the housing for movement in an arc adjacent the backing plate in response to sensing of a physical parameter by the chart recorder;
a digitizer mounted in the housing, the digitizer having a digitizing grid; and
a respective digitizer detectable element mounted on each movable arm.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Rodgers et al. (Rodgers)	4,210,775	Jul. 01, 1980
Louis et al. (Louis)	4,414,634	Nov. 08, 1983

Claims 8-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Louis in view of Rodgers.

OPINION

Upon careful review of the respective positions advanced by appellant and the examiner with respect to the rejections that are before us for review, we find ourselves in agreement with appellant's viewpoint in that the examiner has failed to carry the burden of establishing a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1471-1472, 223 USPQ 785, 787-788 (Fed. Cir. 1984). Accordingly, we will

not sustain the examiner's rejection.

The examiner relies on Louis for disclosing a chart recorder including a housing having multiple movable arms. The examiner acknowledges (final rejection, page 3) that Louis does not disclose:

"a backing plate installed in the housing," "a digitizer mounted in the housing, the digitizer having a digitizing grid: and a respective digitizer detectable element mounted on each movable arm," as stated in claim 8.

The examiner (final rejection, page 3) refers to Rodgers for disclosing a digitizing system with a grid for determining the position of a pen, the pen having a pen tip extending through a coil and a communication link to transmit position data.

According to the examiner (answer, pages 3 and 4), it would have been obvious to one of ordinary skill in the art at the time of the invention to furnish Louis with a backing plate configured for mounting a digitizing grid together with the grid and a pen tip extending through a coil for each arm based on the teachings of Rodgers. The examiner finds a suggestion for this reconstruction of the chart recorder of Louis based on description of prior art in Rodgers at column 1, lines 20-25 wherein it is noted that it is known in the prior art that

electrically transmittable signals denoting the position of a pen or pointer can be sent or recreated at a local or remote utilization device. According to the examiner, the proposed modification of Louis would allow for remote reading of the flow chart (meter).

Appellant (brief, pages 5-8) argues that Rodgers at column 2, lines 32-37 makes it clear that the digitizer apparatus disclosed is for use in "systems using light pens, trackballs, and joy sticks for CRT (cathode ray tube) cursor control" and would not have suggested a modification of the disparate complex chart recorder of Louis that includes linear and rotational sensors and a calculator to perform fluid flow calculations (drawing figure 9) in a manner so as to arrive at the appellant's claimed subject matter.

We agree with appellant. It is well settled that the mere fact that prior art may be modified to reflect features of the claimed invention does not make the modification obvious unless the desirability of such modification is suggested by the prior art. Rejections based on § 103(a) must rest on a factual basis based on the teachings of the prior art. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned

against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

From our perspective, the examiner's proposed combination of Louis and Rodgers appears to be premised on impermissible hindsight reasoning. In this regard, the examiner has not fairly established that one of ordinary skill in the art of designing and building chart recorders of the type described in Louis would have found in the teachings of Rodgers concerning low cost application digitizers for monitoring the position of a pen or other instrument relative to a grid, a suggestion for modifying the chart recorder of Louis in the manner proposed by the examiner.

On the record of this appeal, it is our view that the examiner has not carried the burden of establishing a prima facie case of obviousness with respect to the subject matter defined by the appealed claims. Consequently, we reverse the stated rejection.

CONCLUSION

The decision of the examiner to reject claims 8-17 under 35 U.S.C. § 103 as being unpatentable over Louis in view of Rodgers is reversed.

REVERSED

PETER F. KRATZ)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JAMES T. MOORE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
LINDA R. POTEATE)	
Administrative Patent Judge)	

PFK/sld

Appeal No. 09/938,479
Application No. 2003-2047

Page 7

CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC
1420 FIFTH AVENUE, SUITE 2800
SEATTLE, WA 8101-2347